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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Koji Kida

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12/11/2006

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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/916,581

Applicant(s)

KIDA, KOJI

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-15 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 11/3/06 is sufficient to overcome the prior rejection. A new reference has been added to the 35 USC 103 rejection.

#### **Continued Examination Under 37 CFR 1.114**

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/06 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 2, 4, 5, 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Goldhaber (5,794,210) OR in view of Wilkman (2003/0159150).

Claims 1, 2, 5, 8-11, 13: Gerace discloses a server to which user terminals are connected via a network, this server comprising:

user schedule information storage means for storing user schedule information that has been input from the user terminals (col 9, lines 7-40; col 16, lines 35-67; col 22, lines 10-45; Fig. 4a, 'Travel Schedule');

schedule output means for outputting user schedule information from the aforementioned user schedule information storage means when there has been an access from a user terminal (col 3, lines 39-55; col 9, lines 7-40; col 16, lines 35-67; col 22, lines 10-45);

advertisement data storage means for storing advertisement data that has been input from an advertising provider (Fig. 2; Fig. 3a);

and means for associating the advertisement data stored in this advertisement data storage means with the user schedule information from the user schedule information storage means (Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest'; col 9, lines 7-40; col 16, lines 35-67; col 22, lines 10-45; Fig. 2; Fig. 3a);

wherein: the means for establishing this association includes interest estimation means for estimating, from the contents of the user schedule information, which advertisements the user will be interested in (Fig. 2; Fig. 3a; col 2, lines 1-35; Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest'; col 10, line 50-col 11, line 30);

this interest estimation means includes means for consulting a database in which has

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been stored information relating to what sort of advertising service a particular schedule item corresponds with, and for extracting a keyword serving to extract advertisement data that corresponds with the stored user schedule information (Fig. 2; Fig. 3a; col 9, lines 25-30; col 16, lines 36-55; Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest');

and there is provided advertisement presentation means which uses the keyword extracted by the interest estimation means to associate advertisement data that matches the keyword with the aforementioned user schedule information, and which presents the advertisement data in question along with the user schedule information (Fig. 2; Fig. 3a; col 9, lines 25-30; col 16, lines 36-55; Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest').

Additionally, Gerace discloses advertisement data including at least one keyword corresponding to an advertisement that is input by an advertiser, and that the advertisement keyword can be used for targeting the user (col 18, lines 1-10; col 16, lines 35-55; col 20, lines 9-19). Also, notice in Gerace that advertisements can be a form of agate information/content that is targeted to the user (col 2, lines 60-66). Hence, any of the tracking and/or targeting that occurs for content/information can also occur for advertisements. Also, notice that the advertiser can enter any targeting criteria to target users based on (see preceding citations). Also, notice that users can be targeted based on criteria/keywords match between the user and the advertisement such as Detroit, woman, 25 year old (these example keywords are from the preceding citations from Gerace). Also, notice that advertisements can be placed in messages/notices and targeted based on the message/notice (col 10, lines 46-51).

Additionally, Gerace discloses a server which includes means for storing as user schedule information in the user schedule storage means, as a result of user input, advertisement data that has been presented along with user schedule information (col 6, line 57-col 7, line 40; Fig. 2; Fig. 3a; Fig. 3f; Fig. 3g; Fig. 4b).

Gerace further discloses that the user can indicate categories of interest (col 11, lines 45-56) and that advertisements can be targeted to the categories of interest/information type presented to the user (col 4, lines 29-36). Gerace further discloses that the user can indicate a sponsor interest type/list directly (Fig 3b, "Sponsor interest list (user choose from) DW Pepsi Coke").

Gerace does not explicitly disclose that the user can input a category of interest.

However, Goldhaber further discloses that the user can indicate advertisement categories of interest (Fig. 10; Fig. 11; col 6, lines 58-61; and throughout the Goldhaber disclosure).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's user can indicate/input advertisement categories of interest. One would have been motivated to do this in order to better present content/advertising of interest to the user.

Alternatively, Wilkman discloses that the user can indicate advertisement categories of interest (Paragraphs [103, 104, 105, 86]; Figures 1, 8, 11, 12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's user can indicate/input advertisement categories of interest. One would have been motivated to do this in order to better present content/advertising of interest to the user.

Also, note that Gerace discloses in the above citations targeting the user with advertising based on the schedule and/or the user interests.

Claim 4: Gerace discloses a server according to claim 1, which includes means for storing as user schedule information in the user schedule storage means, as a result of user input, advertisement data that has been presented along with user schedule information (col 6, line 57-col 7, line 40; Fig. 2; Fig. 3a; Fig. 3f; Fig. 3g; Fig. 4b).

Gerace further discloses that the user can indicate categories of interest (col 11, lines 45-56) and that advertisements can be targeted to the categories of interest/information type presented to the user (col 4, lines 29-36). Gerace further discloses that the user can indicate a sponsor interest type/list directly (Fig 3b, "Sponsor interest list (user choose from) DW Pepsi Coke").

Gerace does not explicitly disclose that the user can input a category of interest.

However, Goldhaber further discloses that the user can indicate advertisement categories of interest (Fig. 10; Fig. 11; col 6, lines 58-61; and throughout the Goldhaber disclosure).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's user can indicate/input advertisement categories of interest. One would have been motivated to do this in order to better present content/advertising of interest to the user.

Alternatively, Wilkman discloses that the user can indicate advertisement categories of interest (Paragraphs [103, 104, 105, 86]; Figures 1, 8, 11, 12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's user can indicate/input advertisement categories of

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interest. One would have been motivated to do this in order to better present content/advertising of interest to the user.

Claim 9: Gerace discloses a storage medium in which have been stored programs which, by being installed in an information processing unit, implement the schedule and advertisement presentation system set forth in claims 1 to 4, the server set forth in claims 5 to 7, and the terminal equipment set forth in claim 8 (Fig. 1; Fig. 2; Fig. 3a; col 3, lines 39-67).

Claim 14, 15: Gerace discloses the above. Gerace further discloses advertisement valid time periods and advertisement distribution conditions (col 12, lines 21-56).

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over [Gerace (5,848,396) in view of Wilkman (2003/0159150)] OR [Gerace (5,848,396) in view of Goldhaber (5,794,210) in view of Wilkman (2003/0159150)].

Claim 12: Also, with further regards to claim 12, the prior art discloses the above.

Gerace further discloses advertisement valid time periods and advertisement distribution conditions (col 12, lines 21-56).

Gerace does not explicitly disclose advertisement copying means for enabling the user to copy one or more advertisements to the user schedule, irrespective as to whether or not the advertisement valid time period has expired or will expire.

However, Wilkman discloses these features (Fig. 8; Fig. 1; Fig. 6; Fig. 7).

And, Wilkman further discloses that the user can indicate categories or features for promotions of interest such that the promotion can be sent to the user, sent to the user directly, or placed in the user's calendar ([91]). Wilkman further discloses that the promotions can be stored



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on the user device ([128]). Wilkman further discloses a calendar for displaying promotions of interest and/or a check box for selecting promotions (Fig. 8; [107]). And, Wilkman discloses selecting a promotion(s)/set of promotion(s) that are of interest to the user and are to be displayed to the user ([8]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wilkman's placing particular advertisements on the user schedule/calendar. One would have been motivated to do this in order to better present advertisements/content of interest to the user.

Also, note that in Gerace and/or Wilkman that the advertisement may or may not have an indication of expiration. Or, expiration can be set to an open ended, that is, far in the future date. Hence, expiration need not be a limiting criteria for what is presented, selected, or stored for the user.

6. Claims 3, 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) [in view of Goldhaber (5,794,210) OR in view of Wilkman (2003/0159150)] and in further view of Desai (20050192008).

Claims 3, 6: The prior art discloses a server according to the above.

Gerace further discloses that the advertisement data storage means stores geographical region data serving as a condition for presenting an advertisement;

a user whereabouts estimation means is provided for estimating which geographical region the user is currently in;

and the advertisement presentation means includes means for associating advertisement

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data that corresponds with this estimated user whereabouts with a user's schedule information, and for presenting the advertisement data along with the schedule information (col 10, line 50-col 11, line 30; col 6, lines 5-10; col 8, line 65-col 9, line 7; col 15, line 65-col 16, line 10; col 16, lines 30-36; col 9, lines 9-30; Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest'; col 16, lines 36-55).

Gerace does not explicitly disclose estimating the users location/region from the user's schedule information in the user schedule information storage means.

However, from the preceding citations, Gerace discloses estimating the users location, using user location information to determine information of interest to the user, that user schedule information can be tracked, utilizing user schedule information to determine information of interest to the user, that user travel information can be tracked, that user travel information can be utilized for determining information of interest to the user, that all available information concerning a user, both active and passively obtained, historical, dynamic, and real-time can be tracked and utilized to present information of interest to the user.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Gerace can utilize user schedule information to estimate user region/location.

As a further example of this, Desai discloses targeted advertising based on profiles (Paragraph [226]) and utilizing user schedule information to estimate user region/location:

'[0098] . . . For example, the registered user 12 may provide access to profile information such as its favorite musical or play, its travel schedule and its online calendar to selected vendors 24. The vendors 24 may review the available time periods in the online calendar, review the travel schedule to determine the registered user's 12 location (such as city and hotel) on a given date, and recommend to the registered user 12 a local musical or play based on the registered user's 12 preferences.'

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Gerace can utilize user schedule information to estimate user region/location. One would have been motivated to do this in order to better utilize available user information to determine a parameter for presenting information of interest to the user.

Claim 7: Gerace discloses a server according to claim 5 or 6, which includes means for storing as user schedule information in the user schedule storage means, as a result of user input, advertisement data that has been presented along with user schedule information (col 6, line 57-col 7, line 40; Fig. 2; Fig. 3a; Fig. 3f; Fig. 3g; Fig. 4b).

### *Response to Arguments*

7. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new grounds of rejection.

On page 9 of the Applicant's Remarks dated 11/3/06, Applicant states that the prior art does not disclose:

“user advertisement information interest storage means for storing advertisement interest information regarding which categories of advertisements are of interest to the user, based on inputs provided by the user. . .Also. . .that the interest estimation means estimates, from the user schedule information stored in the user schedule information storage means and the advertisement information stored in the user advertisement information interest storage means, which advertisements a user will be interested”.

On page 9, Applicant also states that the prior art does not disclose:

“there does not appear to be any disclosure of the users being able to input information concerning categories of advertisements that are of interest to those users.”

However, these features are rejected above. Please see the addition of the Goldhaber OR Wilkman reference to the rejection of the independent claims above.

On page 9, Applicant also states that the prior art does not disclose:

“advertisement copying means for enabling the user to copy one or more advertisements to the user schedule, irrespective as to whether or not the advertisement valid time period has expired or will expire.”

However, these features are rendered obvious by the combination of the prior art. Please see the rejection of claim 12 above.

Hence, the combination of the prior art renders obvious the features of the Applicant's claims.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Also, Examiner notes that it must be presumed that the artisan knows something about the art apart from what the references disclose. In *re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. In *re Jacoby*. Also, the conclusion of obviousness may be made

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from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Primary Examiner  
11/21/2006